

REMARKS

In the Final Office Action mailed December 10, 2009, claims 1, 3-17, 19, 22-27, 29-40, 49-51 and 53-56 were pending. Claims 1, 3-10, 12-18, 22-27, 29, 30, 32-40 and 49-51 were rejected, claim 11 was allowed, and claims 31 and 53-56 were objected to but indicated to be allowable if rewritten in independent form incorporating the base claim and any intervening claims. Claims 38 and 49 are amended above, and claims 54-55 are cancelled. Reconsideration and allowance of the subject application including claims 1, 3-17, 19, 22-27, 29-40, 49-51, 53 and 56 are hereby requested.

Claims 1, 12-17, 19, 29, 30, 32-40 and 49-51 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,747,588 to Dillhoff. Claim 1 recites, among other features, “wherein said guide surfaces of said first and second guide members oriented toward one another when said first and second guide members are mounted on said frame and said guide flanges are opposite each other along a length of said first and second guide members and said frame portion is structured to move said guide members away from and toward one another with said guide surfaces remaining parallel to one another.” Dillhoff discloses clamping arms 22, 23, where clamping arm 22 is integral with handle 25 and the arm 23 is pivoted to handle 25 on a pivot 26, where arm 23 is moved by pivoting with channel-like lever 28 pivoted on bar 30. There is no disclosure that handle 25 and lever 30, or that arms 22 and 23, are structured to move clamping member 45, 46 toward and away from one another with guide surfaces of clamping members 45, 46 remaining parallel to one another. Therefore, claim 1 is allowable.

The Final Office Action asserts that the term “structured to” is a functional term “making the limitation a functional limitation, wherein the disclosed references only need to be capable of providing the function. The guide members are pivotally connected to the arms in the Dillhoff reference and are capable of being moved wherein the guide surfaces remain parallel.” The assertion is traversed. The handle 25 and lever 30 and arms 22 and 23 of Dillhoff are not structured to even be capable of moving clamping members 45, 46 away from and toward one another with guide surfaces remaining parallel to one another. In order to maintain surfaces of clamping members 45, 46 parallel to one another while moving clamping members 45, 46 with handle 25 and lever 30 and arms 22 and 23, some additional, undisclosed structure or method

must be employed with the clamping members that would be capable of maintaining the clamping members 45, 46 in parallel relation to one another while arm 23 is pivoted on handle 25, which is not disclosed in Dillhoff. In any event, it is respectfully submitted that just because there is capability does not mean there is anticipation. Instead, anticipation requires disclosure of every element and limitation of the subject claim in the cited reference. Dillhoff lacks any enabling disclosure of the asserted capability.

Claims 12-17 depend from claim 1 and are allowable at least for the reasons claim 1 is allowable and for other reasons. For example, claim 15 recites “wherein said stationary arm and said movable arm each include a lateral extension portion, said lateral extension portions each including a hand-hole extending therethrough.” Dillhoff fails to disclose lateral extension portions that each have a hand-hole extending therethrough, and thus does not anticipate claim 15. Therefore, claim 15 is independently allowable. Withdrawal of the rejection of claims 12-17 depending from claim 1 is respectfully requested.

Claim 19 recites, among other features, “wherein said first and second guide members each include: opposite first and second sides extending between a proximal end and a distal end, wherein said proximal ends are coupled to respective ones of said stationary arm and said movable arm....” In contrast, Dillhoff discloses that arms 22 and 23 are coupled to the middle of clamping members 45, 46. Furthermore, it is respectfully submitted that pivot supports 50 cannot be properly considered to be the proximal ends of clamping members 45, 46 since claim 19 defines that the facing surfaces of the guide members extend “from said proximal end to said distal end between said first and second sides”, and pivot supports 50 are not located at an end of the facing surfaces of clamping members 45, 46.

In the Final Office Action, the Examiner asserts that the clamping members 45, 46 include a” proximal end, i.e., a proximal half of the device, and a distal end, i.e. a distal half of the device, and the arms couple to the guide members in the middle of the guide member and therefore are connected at both the proximal end and the distal end. The claim does not require the arm to be coupled to the terminal distal end of the guide members.” The assertion is traversed. It not clear how the middle of clamping members 45, 46 can reasonably be considered to be an end of clamping members 45, 46. The Office Action appears to divide clamping

members 45, 46 into portions that meet at the middle to support the rejection. However, under the scenario constructed in the Office Action, the clamping members would not have any structure that extends between the “ends”. In contrast, claim 19 recites that each of the guide members includes “said guide surface extending from said proximal to said distal end between said first and second sides”. If clamping members 45, 46 are arranged with proximal and distal halves with connected proximal and distal end as in the manner asserted in the Final Office Action, then there is no guide surface extending from the proximal “end” to the distal “end”. Therefore, Dillhoff does not anticipate claim 19. Withdrawal of this basis of the rejection of claim 19 is respectfully requested.

Claims 29-30 and 32-37 depend from claim 19 and are allowable at least for the reasons claim 19 is allowable and for other reasons. For example, claim 37 recites “wherein said guide surfaces of said first and second guide members are parallel with one another, and said movable arm and said stationary arm are adapted to move said first and second guide members toward and away from one another with said guide surfaces remaining parallel.” As discussed above, Dillhoff does not anticipate these features. Therefore, claim 37 is independently allowable. Withdrawal of the rejection of claims 29-30 and 32-37 depending from claim 19 is respectfully requested.

Claim 38 is amended to include the features of allowable claim 55, and thus is in condition for allowance. Claims 39-40 depend from claim 38. Withdrawal of the rejection of claims 38-40 is respectfully requested.

Claim 49 is amended to include the features of allowable claim 54, and thus is in condition for allowance. Claim 51 depends from claim 49. Withdrawal of the rejection of claims 49 and 51 is respectfully requested.

Claim 50 recites, among other features, “a distal portion including a first guide member extending distally from said first arm and a second guide member extending distally from said second arm, said first and second guide members being movable toward and away from one another in parallel relation by moving said first arm relative to said second arm....” As discussed above with respect to claims 1 and 37, Dillhoff fails to disclose that arms 22, 23 move clamping members 45, 46 in parallel relation by moving arm 23 relative to arm 22. Therefore,

claim 50 is allowable.

Claims 10 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dillhoff in view of U.S. Patent App. Pub. No. 2004/0024291 to Zinkel. Claim 10 depends from claim 1 and is allowable at least for the reasons claim 1. Withdrawal of the rejection of claim 10 is respectfully requested.

Claim 27 recites “a distal portion including a first guide member extending distally from said movable arm and a second guide member extending distally from said stationary arm, said first and second guide members each including a guide surface oriented toward the guide surface of the other of said first and second guide members, said first and second guide members being movable toward and away from one another by moving said movable arm relative to said stationary arm while maintaining said guide surfaces in parallel relation...” As discussed above with respect to claim 1, Dillhoff discloses clamping members 45, 46 are moved by pivoting arm 23 relative to arm 22, and thus do not move clamping members 45, 46 toward and away from one another while maintaining facing surfaces of clamping members 45, 46 in parallel relation. Furthermore, Zinkel teaches non-parallel movement of facing surfaces of the retractor disclosed therein. Therefore, claim 27 is allowable and withdrawal of the rejection of the same is respectfully requested.

Claims 1, 3-9, 12-13, 17, 19 and 22-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,431,658 to Moskovich in view of Dillhoff. Claim 1 recites, among other features, “wherein said guide surfaces of said first and second guide members oriented toward one another when said first and second guide members are mounted on said frame and said guide flanges are opposite each other along a length of said first and second guide members and said frame portion is structured to move said guide members away from and toward one another with said guide surfaces remaining parallel to one another.” The Final Office Action asserts that Moskovich includes guide members 1 and 2 that “are capable of sliding along the length of the arms (24) of the frame and keeping the guide surface parallel during the movement.”

However, there is no disclosure that arms 24 include any structure that is capable of moving guide members 1 and 2 toward and away from one another with the guide surfaces

remaining parallel. Rather, Moskovich discloses an arrangement where guide members are angled so their distal ends are closer to one another than the proximal ends to allow the distal ends to be positioned in the disc space, and then are separated in a non-parallel fashion as bone graft 5 is advanced between the guide members. There is no frame portion of Moskovich that is structured to move the guide members 1 and 2 toward and away from one another with their guide surface remaining parallel to one another. Furthermore, as discussed above, Dillhoff teaches clamping arms 22, 23, where clamping arm 22 is integral with handle 25 and the arm 23 is pivoted to handle 25 on a pivot 26. Arm 23 is moved by pivoting with channel-like lever 28 pivoted on bar 30. There is no teaching that handle 25 and lever 28, or that arms 22 and 23, are structured to move clamping members 45, 46 toward and away from one another with guide surfaces of clamping members 45, 46 remaining parallel to one another. Therefore, withdrawal of the rejection of claim 1 is respectfully requested.

Claims 3-9, 12, 13 and 17 depend from claim 1 and are allowable at least for the reasons claim 1 is allowable. Withdrawal of the rejection of these claims is respectfully requested.

Claim 19 recites “wherein said first and second guide members each include: opposite first and second sides extending between a proximal end and a distal end, wherein said proximal ends are coupled to respective ones of said stationary arm and said movable arm....” As discussed above with respect to claim 19, Dillhoff fails to teach that the proximal end of either of clamping members 45, 46 is coupled to either of arms 22, 23. Rather, Dillhoff teaches that arms 22, 23 are centered on clamping members 45, 46 so that clamping members 45, 46 can be rotated and swiveled through 180 degrees of rotation with respect to the arm 22, 23 to which it is mounted and still be employed to grip structural members between clamping members 45, 46. Based on the teachings of Dillhoff, one of ordinary skill in the art would have no reason to couple proximal ends of guide members to respective ones of a stationary arm and movable arm. Furthermore, Moskovich fails to remedy at least these deficiencies of Dillhoff. Therefore, withdrawal of this basis of the rejection of claim 19 is respectfully requested.

Claims 22-26 depend from claim 19 and are allowable at least for the reasons claim 19 is allowable. Withdrawal of the rejection of claims 22-26 is respectfully requested.

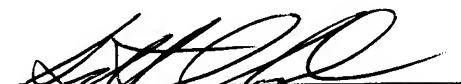
It is respectfully submitted that the present application as amended and including claims 1, 3-17, 19, 22-27, 29-40, 49-51, 53 and 56 is in condition for allowance. Reconsideration of the present application in view of the foregoing remarks is respectfully requested. The Examiner is welcome to contact the undersigned to resolve any outstanding issues with regard to the present application.

Respectfully submitted,

Dated: _____

2/10/10

By: _____



Gregory Scott Dorland
Registration No.: 51,622

Medtronic
Spinal and Biologics
2600 Sofamor Danek Drive
Memphis, Tennessee 38132
Phone: 901 399-2366
Fax: 901 344-1583